

REMARKS

Claims 1-10 are pending. Claims 5-10 have been withdrawn from consideration. Claims 1, 3 and 4 are the only independent claims under consideration. Favorable reconsideration is requested.

Claim 6 was again objected to. Since that claim is withdrawn, it cannot currently be amended. Upon rejoinder after allowance of a generic claim, the claim will be amended at that time in the manner suggested by the Examiner.

Claims 1, 2 and 4 were rejected under 35 U.S.C. § 103 over U.S. Patent 6,714,857 (Kapolka et al.) in view of JP 2002-197155 (Riu et al.) and U.S. Patent 6,636,790 (Lightner et al.). Claim 3 was rejected under 35 U.S.C. § 103 over Kapolka et al. in view of Riu et al. and Lightner et al. and further in view of U.S. Application 2002-089349 Satoshi et al. Applicant traverses.

Just as in the previous Office Action, the Examiner has relied upon two secondary references, Riu and Lightner, in an attempt to supply features conceded as missing from Kapolka et al., the primary reference. Applicant submits that the Office Action has failed to set forth a prima facie case of obviousness.

To establish a prima facie case of obviousness requires, among other things, that motivation in the prior art be identified that would cause one of ordinary skill in the art to make the proposed combination of references. This motivation must be found in the prior art, and it must be a motivation to make the proposed combination of all the cited references.

For example, where a rejection is based upon a combination of three references, as in the case of the rejections of claims 1, 2 and 4, motivation identified that would lead one of ordinary skill in the art to combine *all three*. It is not enough to provide motivation to

combine the first two, and then say that in view of that combination, it would have been obvious to make the additional modification of the combination of the first two references.

In the Office Action, *no* motivation was provided that would have led one to combine all three references. In the “Response to Arguments,” at item 7 of the Office Action, the Examiner stated that “in this case, the motivation for combining the references is found in the knowledge generally available to one of ordinary skill in the art.”

However, while this statement may relieve the Examiner from having to identify exactly *where* the alleged motivation-inducing teachings of the prior art come from, it does not relieve the Examiner of the burden of identifying *what the teachings are*. Instead of identifying such teachings, in the subsequent text of item 7 of the Office Action, the Examiner simply lists the various elements that have been pieced together in the rejection to allegedly meet the claims, and connects them together with the phrase “it would have been obvious.” This is not remotely sufficient to meet the requirement for a *prima facie* case of obviousness.

In addition to failing to identify any teaching in the generally available knowledge that would have motivated the three-way rejection, the only attempt to explain *why* one would be motivated to make the combination is insufficient. Specifically, at page 4 of the Office Action, the Examiner stated that it would have been obvious to combine the references “in order to track working condition of a specific vehicle and to monitor the amount emission to facilitate limiting pollution to the environment.”

However, this is no motivation at all, since it is simply a summary of certain advantages of the Applicant’s invention. As in the last Office Action, the Examiner is, in effect, saying it would have been obvious to combine the references because such a combination would add up to the elements of the claim in question. Such reasoning amounts to an improper hindsight reconstruction of the claims.

For at least the reasons set forth above, the Examiner has failed to establish a prima facie case of obviousness for claims 1, 2 and 4.

As pointed out in the previous response, the rejection of claim 3 is even more deficient than that of claims 1, 2 and 4 since the Examiner has completely failed to provide motivation for a combination of *four* references. Moreover, the Examiner improperly took the combination of the first three references as a given in explaining the further modification based on Satoshi. This is improper since motivation must be shown to combine *all four references*. For at least this additional reason, no prima facie case has been made in connection to claim 3.

In view of the above, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By

Joseph W. Ragusa

Registration No.: 38,586

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas

41st Floor

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant